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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,708	04/10/2001	R. Dennis Nesbitt	P-5686-C1	2621

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Diane F. Covello
Spalding Sports Worldwide, Inc.
425 Meadow Street
PO Box 901
Chicopee, MA 01021-0901

EXAMINER

HUNTER, ALVIN A

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 11/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

S.M.

Office Action Summary

Application No.

09/829,708

Applicant(s)

NESBITT ET AL.

Examiner

Alvin A. Hunter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3 and 23 is/are allowed.
- 6) ☒ Claim(s) 1-7,9-11,13-17,19-22,25,26,28,29 and 32-37 is/are rejected.
- 7) ☒ Claim(s) 8,12,18,24,27,30 and 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Terminal Disclaimer

The terminal disclaimer filed on June 3, 2002 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S Patent No 6057403, 6213895, and 6245859 have been reviewed and accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

1. Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Yabuki et al. (USPN 5482285).

Yabuki et al. discloses golf ball having an inner and outer core with cover in which the outer core is contains a thermoplastic material (See entire document).

2. Claims 25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Kim et al. (USPN 5184828).

Kim et al. discloses a solid golf ball having an inner and outer core with a cover in which the cover may be formed of polyurethane (See entire document).

3. Claim 34 is rejected under 35 U.S.C. 102(b) as being anticipated by Sullivan (USPN 5120791).

Sullivan discloses a golf ball having a cover made of ionomer, in which Sullivan admits is a thermoplastic elastomer (See Background of the Invention and Abstract). Sullivan also notes that the core may be two or more layers (See Column 9, lines 44 through 48).

4. Claim 33 is rejected under 35 U.S.C. 102(e) as being anticipated by Higuchi et al. (USPN 5702311).

Higuchi et al. discloses a golf ball having a multi-layer core, including an innermost core and at least one intermediate layer, surrounded by a cover (See Abstract). In Figure 1B, it is shown that the intermediate layer has two layers; therefore, giving the core a total of three layers (See Column 3, lines 1 through 8).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al. (USPN 5184828) in view of OFFICIAL NOTICE.

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Kim et al. does not disclose the cover made of thermosetting or thermoplastic polyurethane. OFFICIAL NOTICE is taken that thermoplastic and thermosetting polyurethane have similar properties such as toughness, abrasion resistance and impact resistance; therefore, one would have found it obvious to have a cover made of either thermoplastic or thermosetting polyurethane in order to impart toughness, abrasion resistance and impact resistance to the golf ball.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 5, 7, 9-11, 13-17, 19, 21, 22, 32, and 35-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10-28 of U.S. Patent No. 6425833 in view of OFFICIAL NOTICE. U.S. Patent No. 6425833 discloses the same subject matter except for having an inner cover higher or lower than the outer cover at a particular hardness and having center component with a density reducing or increasing agent. OFFICIAL NOTICE is taken that having an high density inner core and lighter outer core gives the ball a low moment

of inertia and that having a higher outer core and lighter inner core gives the ball high moment of inertia; therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add a density reducing or increasing agent to either the center component or the core layer in order to optimize the moment of inertia of the golf ball. OFFICIAL NOTICE is also taken that it is known within the art to used polybutadiene in any core layer to impart resilience to the golf ball, therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the center component made of polybutadiene in order to impart resilience to the golf ball.

Allowable Subject Matter

Claims 3 and 23 are allowed.

Response to Arguments

Applicant's arguments with respect to claims 1-37 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is 703-306-5693. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell, can be reached on (703) 308-2126. The fax phone number for the organization where this application or proceeding is assigned is 703-308-7768.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Paul T. Sewell
Supervisory Patent Examiner
Group 3700